

Support to the amendment of claim 58 may be found, for example, at page 7, line 20 to page 8, line 5 and at page 15, line 1 to page 17, line 19. Support for claim 69 may be found, for example, in claim 58 and at page 8, line 20 to page 9, line 5 of the specification.

## **II. The Rejection Under 35 USC § 112, Second Paragraph**

The Examiner has rejected claim 68 under 35 U.S.C. § 112, second paragraph as being indefinite and vague over the recitation of "wherein the oligonucleotide primer is hybridized to the target" because the Examiner is uncertain whether the claimed reagent itself is present in a form in which it is hybridized to the target nucleic acid or if it only is a property of the claimed reagent that it is capable of hybridizing to the target nucleic acid adjacent to the predetermined position. Applicants respectfully traverse the Examiner's rejection and request reconsideration. However, in the interest of furthering the prosecution of the present application, Applicants have amended the present claim. Applicants respectfully submit that the presently amended claim addresses the Examiner's concerns, and as such, the Examiner's rejection may be properly withdrawn.

## **III. The Rejection Under 35 U.S.C. § 102(e)**

The Examiner has rejected claims 51, 53, 64-66, and 68 under 35 U.S.C. § 102(e) as being anticipated by Erlich. The Examiner has cited the Erlich patent as teaching primers which hybridize to the target nucleic acid so that the 3' nucleotide of the primer is immediately adjacent to a variable nucleotide and extension of the primer results in the addition of a nucleotide complementary to a first or second nucleotide residue. Applicants respectfully traverse the Examiner's rejection and request reconsideration.


In order for a reference to anticipate a claimed invention, that reference must teach each and every element of the claimed invention. See *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). As the Examiner will appreciate, the cited reference fails to teach the a specific labeled nucleotide complementary to the predetermined position of the target nucleic acid. This is significant because without the incorporation of such a labeled nucleotide, a person

of skill in the art is unable to identify the specific nucleotide complementary to the predetermined position of the target nucleic acid. As such, the Examiner's rejection is improper and should be withdrawn.

Having now fully responded to the rejections made by the Examiner, Applicants respectfully submit that the application is now in condition for Allowance, and earnestly solicit early notice of such favorable action. The Examiner is invited to contact the undersigned with respect to any issue in this application.

Respectfully submitted,

Date: 3 December 1995  
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